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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,368	11/10/2000	Michael Dean Whitmarsh	10003975-1	5508

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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,368

Applicant(s)

WHITMARSH ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 9/10/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/10/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 9/10/04.
- Claims 1-26 are pending in applications; Claims 1, 3-14, and 26 have been amended by applicants.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al (U.S. 2003/0140315).

Regarding claim 1, Blumberg discloses a method of processing an image (on-demand print server processes the image before sending to the print provider, pars. 9-15, page 1) before printing of the image by a print provider, the method comprising the steps of:

- (1) defining a print processing system controller (on-demand print server, fig. 3) having a network communication link (Internet network, fig. 3);
- (2) receiving at the print processing system controller a print request (i.e. document/image print order requests with finishing options, fig. 6, pars. 9-15, page 1 and pars. 28-34, page 2) and a data file (i.e. finishing options such as colors selection for print orders/requests, pars. 28-29, page 2) for the image via the network communication link; and
- (3) determining an appropriate application (i.e. determining and selecting the type of output media for print orders, pars. 28-29, page 2) for the image with the print processing system controller based on the image, including processing the print request and the data file for the image to determine the appropriate application (i.e. the server determines which applications such as print media, color and etc that is appropriate for the image, pars. 142-147) for the image by the print processing system controller (on-demand print server receives a print order

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(images/documents printing) with finishing options selected by the users/customers and then on-demand print server determines which print provider most compatible for servicing/printing the print order as requested, figs. 2-6, pars. 9-15, page 1 and pars. 28-34, page 2, and pars. 142-147, page 7).

NOTE: Please see “response to argument” below for more details.

Regarding claim 2, Blumberg further discloses the method of claim 1, wherein the network communication link includes an Internet communication link (Internet communication network, fig. 3).

Regarding claim 3, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller, and wherein receiving the print request and the data file for the image includes receiving the print request and the data file (image data with selected parameters, pars. 28-34, page 2) for the image from the customer via the network communication link.

Regarding claim 4, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller (fig. 3, pars. 148-154, page 7); and reporting the appropriate application (pars. 28-34, page 2) for the image to the customer via the network communication link.

Regarding claim 5, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print provider and the print processing system controller (fig. 3), and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image (i.e. finishing options, pars. 28-34, page 2) from the print provider via the network communication link.

Regarding claim 6, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print processing system controller (communication network, fig. 3) and at least one of a content provider (print provider, par. 34,

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pages 2-3) offering a plurality of images (pre-defined templates, pars. 28-44, pages 2-3) and an application provider offering an application for the image, and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image from the at least one of the content provider (pars. 28-44, pages 2-3) and the application provider via the network communication link.

Regarding claim 7, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes specifying an application for the image (i.e. output media, pars. 28-34, page 2), and wherein the step of determining the appropriate application for the image includes determining whether the application is appropriate for the image.

Regarding claim 8, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes specifying at least one of a print medium size and a print medium type for the image, and wherein determining the appropriate application for the image includes determining whether the at least one of the print medium size and the print medium type (media type and size, par. 28-34, page 2) is appropriate for the image.

Regarding claim 9, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes receiving a request for a plurality of appropriate applications (media type and size, par. 28-34, page 2) for the image.

Regarding claim 10, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate print medium size for the image (media type and size, par. 28-34, page 2).

Regarding claim 11, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate quality (i.e. colors finishing options, pars. 28-34, page 2) for the image.

Regarding claim 12, Blumberg further discloses a method of processing an image before printing of the image by the print provider, the method comprising: defining a print processing system controller having a network communication link; receiving at the print processing controller a print request and a data file for the image via the network communication link; and determining an appropriate application for the image with the print processing system controller, including processing the print request and the data file for the image by the print processing system controller to determine the appropriate application for the image, wherein processing the data file for the image includes determining from the data file at least one of a print resolution of the image, a bit depth of the image, a size of the image, a file size of the image and a quality of the image (par. 28-34, page 2).

Regarding claim 13, Blumberg further discloses the method of claim 12, wherein receiving the print request and the data file for the image includes specifying at least one of a print medium size and a print medium type for the image (media type and size, pars. 28-34, page 2), and wherein the step of determining the appropriate application for the image further includes determining whether the at least one of the print medium size and the print medium type (media type and size, pars. 28-34, page 2) is appropriate for the image.

Regarding claims 14-26 recite limitations that are similar and in the same scope of invention as to those in claims 1-13 above; therefore, claims 14-26 are rejected for the same rejection rationale/basis as described in claims 1-13.

Response to Arguments

3. Applicant's arguments filed 9/10/04 have been fully considered but they are not persuasive.

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- Regarding claims 1, 12, 14, and 26, the applicants argued the cited prior art does not teach/suggest a method for determining an appropriate application for an image based on the image itself.

In response: Blumerg explicitly teaches a method for determining an appropriate application for an image and displays the applied image with selected applications to the users/operators before transmitting to print provider (see claim 1 above for more details).

According to the originally filed specification, the applicants defined determining an appropriate application for image data as: standard paper, transparency, photographic paper, resolution and etc., which can be found on page 7. Clearly, as describes on pages 7-8, print request (print attributes/options for inputted image data) as taught by the applicants are selected manually by operators/users. Print processing controller 28 determines which parameters/attributes/requests have been selected by the operators/users for inputted image data. This does not mean the image is applied and processed “automatically” by the print controller system 28 (that is, selecting and applying the parameters/attributes to the inputted image without user’s intervention) based on the image data and nowhere in any claims recite such limitations. Print server (online on-demand print server as shown in fig. 3) by Blumerg receives image data with selected parameters/options/attributes from remote users/operators, wherein the print server applies the selected parameters/attributes to the inputted image data and displays the processed image data to the users/operators before transmitting to the print provider. Blumerg meets all the limitations in all the claims as recited by the applicants.

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Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

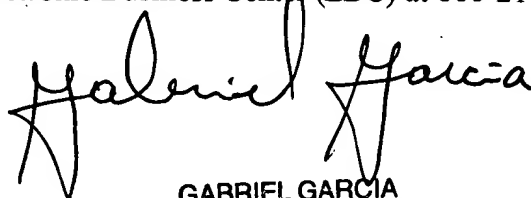
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

A handwritten signature in black ink, appearing to read 'Gabriel Garcia', with a stylized, cursive script.

GABRIEL GARCIA
PRIMARY EXAMINER